



Corres. and Mail
BOX AF

**REPLY AFTER FINAL
EXPEDITED PROCESSING REQUESTED
PATENT**
Customer No. 22,852
Attorney Docket No. 5725.0800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Roland BAZIN et al.) Group Art Unit: 3743
Application No.: 09/725,048) Examiner: Kathryn P. ODLAND
Filed: November 29, 2000) Confirmation No.: 8605
For: PROCESS FOR ACQUIRING)
SCANNED IMAGE DATA)
RELATING TO AN EXTERNAL)
BODY PORTION AND/OR A)
PRODUCT APPLIED THERETO)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO FINAL OFFICE ACTION
AND REQUEST TO WITHDRAW ITS FINALITY**

In response to the final Office Action dated July 28, 2004, the period of response to which has been extended to Monday, November 29, 2004 (November 28th is a Sunday), by the Petition for extension of time and fee payment filed herewith, Applicants respectfully request reconsideration of this application in view of the following remarks.

Claims 1 and 3-63 are pending.

Before explaining why all of the pending claims are allowable, Applicants respectfully request the Examiner to **withdraw the finality of the Office Action**

because it includes new grounds of rejection, which were not necessitated by any amendments. In particular, the finality of the outstanding Office Action should be withdrawn for the following reasons: 1) the Section 103(a) rejection of claims 28 and 29 based on U.S. Patent 6,178,255 to Scott et al. ("Scott") in view of U.S. Patent No. 6,355,439 to Chung et al. ("Chung") is a **new grounds of rejection, which was not necessitated by an amendment**; 2) the Section 103(a) rejection of claims 11-20, 24-29, 37-40, 43-46, 52, 59, and 63 based on U.S. Patent 6,241,668 to Herzog ("Herzog") in view of FR 2736450 ("FR '450"), U.S. Patent No. 5,343,536 to Groh ("Groh"), and JP407274996A ("Kawashima") is a **new grounds of rejection, which was not necessitated by an amendment**; and 3) the Section 103(a) rejection of claims 4-10, 12, 14-16, 18, 38-43, 46-48, and 61-63 based on U.S. Patent No. 5,785,960 to Rigg et al. ("Rigg") in view of FR '450, Groh, and Kawashima is a **new grounds of rejection, which was not necessitated by an amendment**.

For example, the Section 103(a) rejections relying on Kawashima are new grounds of rejection since Kawashima was not cited in the present application prior to the July 28, 2004, Office Action. Those new grounds of rejections, as applied to at least claims 4-20, 24-29, 37-48, 52, 59, and 61-63, were not necessitated by any amendment inasmuch as a) claim 63 was not amended in the Amendment filed April 28, 2004, and b) independent claims 4, 11-14, 24, 25, 37, 38, 46, 48, 52, 59, and 61 were amended in the Amendment filed April 28, 2004 merely to place those claims in independent form without changing their scope.

According to M.P.E.P. § 706.07,

present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that

will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. . . . The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

To provide Applicants with a full and fair opportunity to respond to the final Office Action, Applicants respectfully request the Examiner to consider the above remarks and to withdraw the finality of the Office Action. If the Examiner refuses to grant this request to withdraw the finality of the Office Action, Applicants respectfully request the Examiner to inform Applicants immediately in order to expedite the filing of a possible petition to the Group Director requesting withdrawal of the finality of the Office Action.

In the Office Action, claim 11 was rejected under "35 U.S.C. 102(a and/or e)" based on U.S. Patent No. 6,533,971 to Stess et al. ("Stess"). Stess discloses a method of forming a custom molded orthopedic impression shirt, wherein the method includes first mounting a release shirt or layer on a patient's torso and then mounting a resin-impregnated impression shirt over substantially the entire release shirt. (Col. 2, lines 20-31.) The resin of the impression shirt is allowed to harden and then the hardened impression shirt is removed from the torso. (Col. 2, lines 31-34.) Stess further discloses using a digital scanner 51 to scan the outside or inside of the hardened impression shirt so that an orthosis may be formed. (Col. 6, lines 3-27).

Applicants respectfully submit that the claim rejection based on Stess should be withdrawn because that reference does not disclose or suggest all of the subject matter recited in independent claim 11. For example, Stess does not disclose or suggest "scanning . . . with an optical image scanner to obtain scanned image data for an

image," as set forth in claim 11. Based on the Examiner's comments in the prior Office Action, Applicants believe the Examiner could be equating Stess's general disclosure of a digital scanner 51 with an "optical image scanner." Contrary to the Examiner's apparent assertion, there is nothing providing any express or inherent teaching of the recited "scanning . . . with an optical image scanner to obtain scanned image data for an image." Since the purpose of Stess's disclosed digital scanner 51 relates to proper dimensioning of an orthosis, one of ordinary skill in the art would understand that Stess's scanner 51 would merely obtain dimensions of the impression shirt rather than obtaining any "image data" for an "image." Accordingly, the Section "102 (a and/or e)" rejection should be withdrawn.

In addition to the fact that the rejection of claim 11 should be withdrawn because Stess does not have any teaching of "scanning . . . with an optical image scanner to obtain scanned image data for an image," the rejection of claim 11 should also be withdrawn because Stess does not have any teaching of "placing moldable material in contact with the skin of the individual to produce, on the moldable material, the surface profile of the skin," as recited in claim 11. Contrary to the Examiner's assertion, Stess's disclosure of mounting an impression shirt over a release shirt without contacting the impression shirt with skin cannot be equated with the subject matter recited in claim 11. Even though Stess mentions bonding the layer 25 to the impression shirt layer 27 (col. 5, lines 36-41), such disclosure does not provide any teaching of placing moldable material in contact with skin because the bonding of layers 25 and 27 occurs only after the impression shirt 27 hardens and thus becomes non-moldable, and, more

importantly, because there is no mention of the impression shirt material itself contacting skin.

For at least these reasons, the claim rejection based on Stess should be withdrawn.

Claims 52 and 53 were rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,343,536 to Groh ("Groh").

Groh does not disclose "scanning . . . a calibration member having one of a predetermined size and a predetermined color," as recited in claim 52. Contrary to the Examiner's assertions, column 5 of Groh does not disclose scanning a calibration member. The mere disclosure in that reference relating to the use of software in connection with grey levels has no teaching of a calibration member being scanned.

Regarding the Section 102(b) rejection of claim 53, Applicant respectfully submits that the rejection should be withdrawn because claim 53 depends from claim 1 and should therefore be allowable over Groh for at least the same reasons claim 1 is allowable over that reference. Since the prior Section 102(b) rejection of claim 1 was withdrawn, the rejection of dependent claim 53 should likewise be withdrawn.

For at least the reasons discussed above, the Section 102(b) rejection of claims 52 and 53 should be withdrawn.

Focusing on the Section 103(a) rejections appearing in the Office Action at pages 9-16, Applicants respectfully submit that those rejections should be withdrawn because the Office Action does not set forth a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. M.P.E.P. § 2143. Second, there must be a reasonable expectation of success. Id. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements and limitations. Id. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) and M.P.E.P. § 706.02(j). The mere fact that a reference is capable of being modified does not provide the sole basis for an obviousness rejection. M.P.E.P. § 2143.01.

Claims 1, 21, 22, 49, 50, 58, and 60 were rejected under 35 U.S.C. § 103(a) based on Groh in view of Kawashima.

In the Office Action, the Examiner acknowledges that Groh does not have any teaching of adhesive material of a transfer member being placed in contact with skin while the adhesive material is on a backing of the transfer member, as recited in claim 1. Despite that acknowledged deficiency, the Examiner cited Kawashima for the asserted disclosure of "tacky tape as a transfer member for observing skin through a scanner." Office Action at 9.

Applicants respectfully disagree with the Section 103(a) rejection based on Groh and Kawashima. Groh relates to a method for evaluating comedones on the skin through the use of follicular biopsy slides and image analysis. Col. 1, lines 7-9. Kawashima, on the other hand, concerns a method for observing fungus existing on a keratin layer of skin. Applicants respectfully submit that the Office Action has not set

forth a *prima facie* case of obviousness because there is no plausible reason why one of ordinary skill in the art would have looked to a reference dealing with fungus observation in order to modify Groh's dissimilar subject matter relating to evaluation of comedones on the skin.

Applicants respectfully submit that the Office Action appears to misstate the teachings of Kawashima. Rather than having any teaching of "tacky tape as a transfer member for observing skin through a scanner," as asserted Office Action at 9, the English language abstract of Kawashima does not have any mention of a scanner. Accordingly, the Examiner appears to have misconstrued the teachings of that reference, and nothing in the Office Action provides any support for the assertion concerning a scanner.

Moreover, one of ordinary skill in the art would not have had any reason to use anything other than the non-adhesive glass slide 11 disclosed in Groh because Groh specifically teaches that "[t]he material of the microscopic slide 11 is preferably a material that is non-reactive to cyanoacrylate, and is most preferably glass as glass slides tend to be more durable than thinner, film slides." Col. 4, lines 10-14. The English abstract of Kawashima does not have any mention of the "tacky tape" being non-reactive to cyanoacrylate. In addition, since "tape" is generally made of thin, flexible, non-glass material, Kawashima's "tacky tape" would more than likely not be made of glass or more durable than thin film slides, as required by Groh at col. 4, lines 10-14. Thus, Groh teaches away from the hypothetical combination proposed in the Office Action.

For at least these reasons, Applicants submit that the Section 103(a) rejection based on Groh and Kawashima should be withdrawn.

Claims 12, 14-16, 25-32, 52, and 63 were rejected under 35 U.S.C. § 103(a) based on Scott in view of Chung.

Applicants respectfully submit that this Section 103(a) rejection should be withdrawn for at least the following reasons.

The Office Action has not established a *prima facie* case of obviousness because the Office Action does not set forth any legally sufficient suggestion or motivation for using Scott's fingerprint scanner for scanning anything other than fingerprints.

Applicants disagree with the Examiner's assertion that "it is well known to expand fingerprinting to include other body parts such as toes." Office Action at page 4.

Contrary to the Examiner's assertion, the term "**fingerprinting**," by definition, relates to the **fingers**, not toes or other body parts. Furthermore, the mere mention of taking fingerprints and toeprints in "My Sweet Baby Zachary" by Susan Holstine does not provide any suggestion for fingerprinting to include toeprinting, and more importantly, does not suggest using a fingerprint scanner to take prints of toes or other body parts.

In fact, since the Susan Holstine "internet blog" refers to both fingerprinting and toeprinting, it is clear that they are different from one another and that fingerprinting would not encompass taking prints of body parts other than the fingers. Further, even if there might have been situations where fingerprints and toeprints of new-born babies have been taken, there would have been no suggestion or motivation for using a scanner to take such prints, and there clearly would have been nothing to suggest using a

Scott's finger scanner to scan toes since toe prints are not used by governmental agencies to identify individuals. (See, e.g., Scott at col. 2, lines 10-12.)

There is simply no reason why one of ordinary skill in the art would have been motivated to use Scott's fingerprint scanner for scanning anything other than fingerprints. Independent claims 1, 12, 14, 25, 52, and 63 recite a "transfer image [that] is not a fingerprint or fingerprints." Therefore, those claims are patentably distinguishable from the subject matter of Scott.

Furthermore, nothing supports the Examiner's assertion that "it would be obvious to expand the system to include other body parts such as toe prints for the purpose of obtaining and database storing data of scanned image." (Office Action at 11.) Chung concerns a method of obtaining DNA samples. The disclosure of Chung does not provide any motivation or suggestion for using a fingerprint scanner, such as that of Scott, in any manner other than for scanning fingers. In particular, Chung does not provide anything supporting the Examiner's assertion that it would have allegedly been obvious to use Scott's fingerprint scanner to scan "other body parts." There is simply no reason why one of ordinary skill in the art would have had any motivation to modify Scott's fingerprint scanner to include any of Chung's subject matter relating to DNA sampling.

In addition to the fact that the claim rejection should be withdrawn because there is no suggestion or motivation for the Examiner's proposed modification, Applicants submit that the claim rejection should also be withdrawn because Scott does not disclose or suggest "scanning [a] transfer image," as recited in claims 1, 12, 14, 25, 52, and 63. Contrary to the Examiner's assertion in the Office Action at page 5, there is no

significance relating to the mere possibility that one or more fingerprint impressions might remain after touching Scott's platen 72. **Even if a fingerprint impression might remain on Scott's platen 72 after it is touched, there is no disclosure of scanning that fingerprint impression.** Rather than scanning a print impression left by a finger, Scott discloses directly scanning one or more fingers alone, **not a fingerprint impression**, to acquire an optical image of the actual fingers. (See col. 2, lines 8-10, and col. 4, line 39 through col. 5, line 6.) Accordingly, Scott has no disclosure or suggestion of the claimed "scanning [a] transfer image" and Chung would have provided no suggestion of that subject matter.

Further, neither Scott nor Chung discloses or suggests a "scanner configured in the form of a scanner for scanning documents," as recited in claim 63, for example.

For at least these reasons, the Section 103 claim rejection relying on Scott and Chung should be withdrawn.

Claims 1, 11-40, 43-46, 49-53, and 63 were rejected under 35 U.S.C. § 103(a) based on Herzog in view of FR '450 and Groh, and further in view of Kawashima.

Applicants respectfully submit that the claim rejection based on Herzog, FR '450, Groh, and Kawashima should be withdrawn because there is no *prima facie* case of obviousness.

In addition to citing the four references mentioned in the rejection statement at page 11, the Office Action at page 5 cites two additional references, Rose, "MU unveils pilot program for distance plant diagnosis" (hereinafter "Rose") and La Rosa, "High Resolution and Low Cost Static Telepathology" (hereinafter "La Rosa"). Rose and La Rosa do not provide any suggestion or motivation to modify the other cited

references in a manner that would suggest the claimed subject matter. Rather than relating to the field of acquiring scanned image data relating to an external body portion and/or a product applied to a body portion, Rose relates to the non-analogous art of identifying insects and plants such as weeds. Further, contrary to providing any suggestion to use Herzog's scanner, as apparently proposed by the Examiner, Rose in its concluding paragraph touts the "big advantage" of using a digital camera in place of a scanner because a digital camera is portable and also able to accommodate large mushrooms. Thus, Rose teaches away from the Examiner's hypothetical proposal to use a scanner.

Turning briefly to La Rosa, even though that reference mentions a pathological technique involving a scanner used to scan histological glass slides, nothing in that reference provides any suggestion of using Herzog's scanner 16 to scan anything other than "additional documents, reports, graphics and/or films," as described in Herzog at col. 3, lines 32-34. La Rosa also does not have any teaching or suggestion of scanning an image of a transfer member that has been obtained by placing the transfer member in contact with an external body portion, as recited in the rejected claims. For example, since there is nothing more than a general mention of La Rosa's histological glass slides, there is no teaching of placing those slides in contact with an external body portion.

Despite Applicants' previous request, the Examiner has still not explained the basis for the allegations that Herzog "discloses . . . placing a transfer member in contact with an external portion of an individual . . . and scanning the transfer image" and that "it is within the scope of [Herzog's purported] invention to use the scanner for obtaining

human scanning information.” Office Action at 11. In addition, the Office Action provides absolutely nothing to support the allegation at page 13 concerning the alleged obviousness of using “transfer members in the system of Herzog.”

Contrary to the Examiner’s apparent assertions, FR ’450, Groh, and Kawashima do not provide any suggestion or motivation to use Herzog’s scanner 16 for anything other than scanning “additional documents, reports, graphics and/or films.” Col. 3, lines 32-34. Applicants do not subscribe to the Examiner’s assertion about subject matter that is allegedly “well known” and/or the subject of “thousands of patents and applications.” Office Action at 12. If the Examiner insists on maintaining the rejection, Applicants respectfully request the Examiner to supply an explanation of how FR ’450, Groh, and Kawashima are being applied and to also set forth where FR ’450 allegedly “teaches transferring human data via scanning,” as alleged in the Office Action at page 12.

In addition to the fact that there is no motivation or suggestion to combine the references as proposed by the Examiner, Herzog, FR ’450, Groh, and Kawashima do not provide any teaching or suggestion of “moldable material,” as recited in claim 11; scanning a transfer image of a “transfer member [that] is a window,” as recited in claim 12; a “transfer member [that] is one of a hair comb and a hair brush,” as recited in claim 13; “comparing the displayed image to at least one image formed from image data stored in an image database,” as recited in claim 37; “determining a recommendation,” as recited in claim 38; “analyzing at least one characteristic of a product,” as recited in claim 46; a “calibration member,” as recited in claim 52; or “analysis equipment,” as recited in claim 59, for example.

Claims 1, 3-10, 12, 14-16, 18, 38-43, 46-50, and 60-63 were rejected under 35 U.S.C. § 103(a) based on Rigg in view of FR '450 and further in view of Groh, and further in view of Kawashima.

Rigg's disclosure concerns customizing skin foundation products. Contrary to the assertion in the Office Action at page 6, Rigg does not generally teach remote skin analysis. Although Rigg's system includes a portable skin analyzer 2 that measures skin coloration and transfers the resultant reading or signal, the system of Rigg uses that skin coloration measurement to customize a cosmetic product, not to conduct telemedicine as discussed in FR '450. Furthermore, Rigg's skin analyzer 2 is not an optical image scanner and it is not used to scan a transfer image of a transfer member.

Applicants respectfully submit that the Section 103(a) rejection based on Rigg in combination with FR '450, Groh, and Kawashima should be withdrawn because the Office Action does not establish any reasonable suggestion or motivation for one of ordinary skill in the art to have combined Rigg's skin foundation product customizing subject matter with the completely different subject matter disclosed in FR '450, Groh, and Kawashima. At page 15 of the Office Action, the Examiner admits that Rigg lacks any teaching of an optical image scanner and placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image. Despite those acknowledged shortcomings, the Examiner cites FR '450 for the asserted teaching of telemedicine with optical imaging and the Examiner also cites Groh for the asserted teaching of scanning a transfer member with an adhesive. The Office Action, however, does not provide any legally sufficient suggestion or motivation establishing why one of

ordinary skill in the art would have modified Rigg's foundation customizer to include such asserted subject matter.

For example, the Office Action does not identify any sources supporting the allegations on page 6 concerning "enhanced image quality" and a "more robust system." Since there is no suggestion or motivation for using Rigg's portable skin analyzer 2 to obtain an image, there is simply no legitimate reason for alleging that there would be a reason for modifying the subject matter for the alleged purpose of enhancing image quality. Furthermore, the hypothetical modifications apparently proposed in the Office Action appear to be directed to making a much more complicated arrangement, rather than increasing robustness.

In light of all of the differences between the subject matter of Rigg, FR '450, Groh, and Kawashima, there simply is no reason why one of ordinary skill in the art would have made the modifications proposed in the Office Action.

Further, neither Rigg, nor FR '450, nor Groh, nor Kawashima supplies any teaching or suggestion of "moldable material," as recited in claim 11; or a scanner "configured in the form of a scanner for scanning documents," as recited in claim 63, for example.

Turning to another issue, the Office Action at page 6 notes that the present specification discloses numerous transfer members and external areas, and then alleges that "they are considered equivalent since they perform the same function of obtaining scanned information." Applicants respectfully disagree with the Examiner's allegation that each of the disclosed transfer member is "equivalent" and Applicants also disagree with the Examiner's allegation that the transfer members function to obtain

scanned information. For example, the Examiner's statement appears to reflect that the Examiner has overlooked the fact that the present disclosure relates to an optical image scanner that scans a transfer image to obtain scanned image data. The transfer members are not disclosed as obtaining scanned information without a scanner.

Furthermore, Applicants respectfully disagree with the Examiner's apparent attempt to apply the teachings of Applicants' disclosure as a reference source in the claim rejections. Such reliance on the present disclosure amounts to improper hindsight. Moreover, since the Office Action does not meet the burden of establishing a *prima facie* case of obviousness, there is no need for the Applicant to demonstrate criticality for any subject matter.

For at least the reasons set forth above, all of the claim rejections should be withdrawn and all of the claims should be allowable.

The claim rejections contain numerous conclusory assertions about certain subject matter being disclosed or being obvious. Applicants do not understand the basis for many of the Examiner's assertions because the Office Action lacks any explanation of how the cited references allegedly disclose such subject matter and/or allegedly render it obvious. If the Examiner insists on maintaining any of the claim rejections, Applicants respectfully request that the Examiner set forth a detailed explanation of the basis for all of the assertions contained in the claim rejections.

Turning to another issue, the Office Action at page 2 notes that an IDS was filed on April 28, 2004¹ and that a PTO 1449 form does not appear in the PTO file for the application. No PTO 1449 form was filed with that IDS.

The Office Action at page 2 also requests "English translation and/or equivalents" for the foreign documents cited in the IDS dated January 13, 2004. To the undersigned's knowledge, Applicants do not have any such "English translation and/or equivalents" other than any information that has already been submitted. On page 2 of the IDS filed on January 13, 2004, Applicants provided remarks concerning English language documents relating to each of the foreign references submitted along with that IDS. Those remarks and the corresponding English language documents mentioned therein were submitted to provide a concise explanation of each reference. Accordingly, all of the references cited in the IDS filed on January 13, 2004, should be considered, especially in light of the information discussed on page 2 of the IDS. See 37 C.F.R. § 1.98(a)(3)(i).

Applicants respectfully request that the Examiner reconsider the application, withdraw the claim rejections, and issue a Notice of Allowability in a timely manner.

If a telephone conversation might advance prosecution of the present application, the Examiner is invited to contact the undersigned (571-203-2774).

Applicants note that the Office Action contains numerous assertions regarding the pending claims, Applicants' invention, the cited references, purported inventions of the cited references, and alleged "well-known" and/or inherent information, for example. Applicants respectfully disagree with a number of those assertions and decline to

¹ The Office Action incorrectly notes that the filing date of the IDS was April 26, 2004.

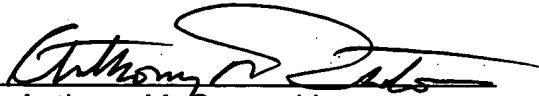
automatically subscribe to any of them, regardless of whether they are specifically identified above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 29, 2004

By: 
Anthony M. Gutowski
Reg. No. 38,742